

AMENDMENTS TO THE DRAWINGS:

The attached drawing sheets include changes to Figs. 10-15. These sheets replace the original drawing sheets for Figs. 10-15.

REMARKS

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

I. CLAIM STATUS AND AMENDMENTS

Claims 1-9 were pending in this application when last examined and stand rejected.

Claims 1-4 and 7-9 have been cancelled without prejudice or disclaimer thereto. Applicants reserve the right to file a continuation or divisional application on any cancelled subject matter.

Claims 5 and 6 have been amended and new claims 10-13 have been added.

Minor editorial revisions have been made to the claims 5 and 6 to better conform to U.S. claim form. Such revisions are non-substantive and not intended to narrow the scope of protection. Support can be found in original claims 5 and 6.

New claims 10 and 11 correspond to claims 5 and 6, respectively, but further specify the nature of the gasket material. New claims 12 and 13 also correspond to claims 5 and 6, respectively, but are written without the product-by-process language.

Claims 10-13 are pending upon entry of this amendment.

No new matter has been added by the above claim amendments.

Applicants have replaced the specification of record with the attached substitute specification. The substitute specification corresponds to the original specification, except for minor editorial revisions to correct grammatical and typographical errors made during the translation and to thereby better conform to US English form. No new matter has been added.

Replacement drawings for Figs. 10-15 are attached herewith to replace original drawing sheets for Figs. 10-15. Figs. 10-15 have been revised to use the legend "Prior Art" as suggested by the Examiner. No new matter has been added.

Applicants are submitting the present Amendment without prejudice to the subsequent prosecution of claims to some or all of the subject matter which might be disclaimed by virtue of this response (although none is believed to be), and explicitly reserve the right to pursue some or all of such subject matter, in Divisional or Continuation Applications.

Applicants thank the Examiner for the careful examination of this case and respectfully request reexamination and reconsideration of the case, as amended. Below Applicants address the rejections in the Office Action and explain why the rejections are not applicable to the pending claims as amended.

II. INFORMATION DISCLOSURE STATEMENT

Attached to the Official Action was an Examiner-initialed PTO-1449 form for the Information Disclosure Statement (IDS) filed May 27, 2005. However, it is noted that the Examiner did not check-off/initial the reference Murakami et al. (US 7,048,278). Accordingly, it is unclear whether this reference has been officially considered. Therefore, the Office is requested to kindly consider this reference and return an Examiner-initialed PTO-1449 form indicating such.

III. OBJECTIONS TO THE DRAWINGS

The drawings were objected for not including a legend designating Figs. 10-15 are "Prior Art" for the reason in item 1 on page 2 of the Office Action.

Applicants have submitted replacement drawing sheets for Figs. 10-15 to correct this informality. Thus, the present amendment overcomes this objection as to the drawings.

IV. OBJECTIONS TO THE SPECIFICATION

The specification was objected on the basis that is a literal translation into English from a foreign document and is replete with grammatical and idiomatic errors. See item 2 page 2 of the Action.

The present amendment overcomes this concern by submitting a revised substitute specification to correct

grammatical and idiomatic errors. Thus, withdrawal of the above objection is solicited.

V. INDEFINITENESS REJECTION

Claims 1-9 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for the reasons in item 4 on pages 2-4 of the Office Action.

Applicants believe that the present amendment fully addresses and overcomes this rejection as the claims have been amended to better conform to US practice and claim form. The claims are thus clear, definite and have full antecedent basis.

This rejection is believed to be overcome, and withdrawal thereof is respectfully requested.

VI. PROVISIONAL DOUBLE PATENTING REJECTION

Claims 1, 5 and 6 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being allegedly obvious over claims 1 and 14 of copending application serial No. 10/520,177 for the reasons in item 6 on pages 4-5 of the Office Action.

For the sole purpose of expediting prosecution and not to acquiesce to the rejection, Applicants respectfully submit that the attached Terminal Disclaimer obviates this rejection.

VII. PRIOR ART REJECTIONS

Claims 1, 3, 5, and 6 were rejected under 35 U.S.C. § 102(b) as anticipated by LINDEMAN (U.S. 4,330,442) for the reasons in item 8 on page 5 of the Office Action.

Claims 2, 4, and 7-9 were rejected under 35 U.S.C. § 103(a) as being obvious over LINDEMAN for the reasons in item 10 on page 6 of the Office Action.

These rejections are respectfully traversed as applied to the amended and new claims. The rejections will be addressed together as LINDEMAN is the sole reference used throughout.

It is well established that to anticipate a claim, a cited prior art reference must disclose or suggest each and every element of the claimed invention. See, M.P.E.P., Eighth Ed., Rev. 6 (September 2007) at § 2131.

It is well established that to support a *prima facie* case of obviousness, the Office must provide a rationale showing that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions to yield predictable results. See, *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 U.S.P.Q.2d 1385, 1395 (2007); and M.P.E.P., Eighth Ed., Rev. 6 (September 2007) at § 2143.02.

The gasket material according to remaining amended independent claim 5 and new independent claim 10 is manufactured

from a joint seat, including 2 to 26 wt% of phenol resin, as the filler. New independent claim 12 also recites a gasket material comprising, among other elements, 2 to 26 wt% of phenol resin, as the filler.

Applicants respectfully submit that LINDEMAN fails to disclose or suggest this feature of "2 to 26% by weight of phenol resin as the filler" of claims 5, 10 and 12. Such phenol resin as the filler (e.g. resol type phenol resin) is a precursor of phenol resin and is mixed with rubber, reinforcing fiber and other filler by means of the calender roll so as to form an ingredient for the joint seat. By mixing the phenol resin as the filler, the ingredient takes on moderate adherence to the surface of the running hot roll with a high temperature. This is favorable so the ingredient can form the joint seat by the calender roll using a hot roll.

By contrast, in LINDEMAN, there is described a gasket that does not include phenol resin as the filler. Instead, LINDEMAN uses a phenolic fiber as the reinforcing fiber for the gasket. It is noted that such phenolic fiber is not a precursor of a phenol resin, because it must retain the form of fiber. Therefore, by mixing the phenolic fiber as the reinforcing fiber, the ingredient cannot take on moderate adherence to the surface of the running hot roll with high temperature.

Thus, it is clear then that LINDEMAN fails to disclose or suggest each and every element of the claims. Thus, the

rejection must fall, because LINDEMAN fails to disclose or suggest the above-noted feature of independent claims 5, 10 and 12.

Thus, the above-noted anticipation and obviousness rejections over LINDEMAN are untenable and should be withdrawn.

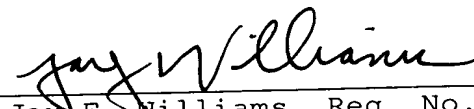
VIII. CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the present application is in condition for allowance and early notice to that effect is hereby requested. If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned attorney at the telephone number below.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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APPENDIX:

The Appendix includes the following item:

- a Replacement Sheets for Figures 10-15 of the drawings
- a Substitute Specification and a marked-up copy of the originally-filed specification
- a terminal disclaimer